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Application No. 10/825,178

REMARKS

Reexamination and reconsideration of this application is respectfully requested in light of the following remarks.

Claims 20 and 21 are pending in this application. Claims 1-19 were previously canceled. No new claims have been added. Claims 20 and 21 have not been amended by this response.

The Rejection

Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Philips (Derwent Abstract to NL8600728), Ikenishi et al. (U.S. Published Application No. 2003/0109370) and Suzuki (JP 2000182316). It is respectfully requested that the rejection of claims 20 and 21 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

The Examiner asserts that "[i]t would have been obvious ... to utilize the step of detecting the center of gravity and the detecting means of Suzuki in the process [of] Philips and Ikenishi in order to provide for a well balanced recording medium and prevent reading errors." Applicant respectfully disagrees.

According to the Examiner, Philips discloses a process for manufacturing a glass substrate with a center hole to be used as a recording medium. While the Examiner acknowledges that Philips does not have an explicit teaching, the Examiner finds that it would have been obvious to a person of ordinary skill in the art to detect the position of the center hole by detecting the center of gravity. This finding is based on a mere conclusion is not supported by evidence or prior art of record in this patent application. *In re Thrift*, 298 F.3d 1357, 63 USPQ2d 2002, (Fed. Cir. 2002). Reliance on what the Examiner regards as what to expect does

Application No. 10/825,178

not fulfill the Examiner's obligation to cite references in support of his or her conclusion. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Philips discloses a method of producing is a compact disc by preparing two single discs by injection molding (see the abstract) and welding the two single discs together. Philips method differs from Applicant's method in that Applicant claims press molding, and not injection molding. Further, the center hole in each of Philip's single discs are already present in the single disc when it is removed from the mold. Therefore, because each single disc already has a hole, a person of ordinary skill in the art would not have been led from the teachings of Philips to detect the center hole using the center of gravity and then to create the center hole. The abstract discloses that the mass of the compact disc formed by the two single discs is "evenly distributed with centre of gravity in centre of hole." This disclosure is not directed to detecting a center of gravity of the compact disc and creating a hole as required by the claims, but insuring that compact disc mass is "evenly distributed."

The Examiner finds that Ikenishi et al. disclose a process of manufacturing a glass substrate by melting glass, flowing the glass into a mold, press molding the glass and creating a center hole in the glass. Ikenishi et al. are primarily concerned with the properties and composition of the glass. According to Ikenishi et al., a center hole in the glass is formed using a cylindrical grinder in the "central portion of the glass substrate" (§ [0125]). There is no disclosure or suggestion in Ikenishi et al. of using a center of gravity method to determine the location of the center hole and then cutting the center hole using the cylindrical grinder. Therefore, this reference does not make up for the deficiency of Philips.

Application No. 10/825,178

As for Suzuki, this reference also does not make up for the deficiencies of Philips or Ikenishi et al. Suzuki discloses a method for detecting the gravity of CD-ROM, which already has a center hole provided therein. It is not directed to detecting the location of a center hole using a center of gravity method and then creating the center hole based on the center of gravity. Suzuki's method requires that the CD-ROM be fitted into a spindle motor which rotates the CD-ROM. The spinning apparatus disclosed by Suzuki detects a deviation from the center of gravity of the CD-ROM. When the deviation is detected, the disc is weighted to compensate for the deviation to eliminate vibration. According to Suzuki, his method is similar to balancing an automobile tire (§ [0022]).

The technique disclosed and taught by Suzuki would not have led a person skilled in the art to detect the center of gravity in a substrate and to create a center hole so that the center of gravity is the center of the hole. In other words, Suzuki teaches determining the deviation from the center of the center hole, and not determining the position for creating a center hole. Notwithstanding these facts, Suzuki is not directed using center of gravity to create a center hole. At the time a disc is undergoing measurement to determine the deviation of the center of center of gravity, the disc already has the center hole formed therein.

Accordingly, Suzuki does not make up for the deficiencies of Philips and Ikenishi et al. It would not have been within the skill of the art to modify Philips or Ikenishi et al. by Suzuki since none of the references, taken alone or in combination, discloses a method comprising the combined steps of (i) detecting the center of gravity of a glass substrate and (ii) creating a center hole so that the center of gravity becomes the center of the center hole.

Application No. 10/825,178

For all of the foregoing reasons, the rejection does not present a *prima facie* case of obviousness over the combined teachings of Philips, Ikenishi et al. and Suzuki. Hence, it is respectfully requested that the rejection of claims 20 and 21 under 37 U.S.C. § 103(a) be reconsidered and withdrawn.

Conclusion

Favorable reconsideration of the claims is requested in light of the preceding amendments and remarks. Allowance of the claims is courteously solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. § 1.17 and due in

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MAY 20 2008

Application No. 10/825,178

connection with the filing of this paper, including extension of time fees, to Deposit Account
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Respectfully submitted,

McDERMOTT WILL & EMERY LLP



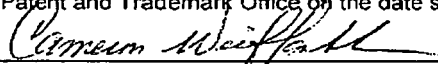
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